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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,016	02/07/2001	Dan Vassilovski	010125	5626

23696 7590 05/06/2003

Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
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EXAMINER

LEVITAN, DMITRY

ART UNIT

PAPER NUMBER

2662

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/779,016

Applicant(s)

VASSILOVSKI ET AL. 

Examiner

Dmitry Levitan

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,10 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,6,8,9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "said identification code" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 5, 7, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hardy (US 6,356,638).

Regarding claims 1 and 2, Hardy teaches an apparatus for a transparent service option transition between first communication device (digital subscriber unit 220 on Fig. 1 and id 2:37-

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39, 53-60) and a second communication device (analog terminal 232 on Fig. 1 and id 2:37-41, 50-52), comprising:

Said first communication device (digital subscriber unit 220), comprising:

A processor (inherently part of digital subscriber device 220, because all cellular phones comprise a processor) for establishing a first communication (establish unencrypted digital link 104-108 on Fig. 3 and id 2:64-67, 3:1-18, 29-34) with second communication device using a first service option (end-to-end unencrypted channel);

A storage device (inherently part of digital subscriber unit 220, because all cellular phones comprise memory for phone numbers) for storing an identification code (a phone number of a second communication device) corresponding to said second device; and

Said processor further for terminating said first communication (establish unencrypted digital link 104-108 on Fig. 3 and id 2:64-67, 3:1-18, 29-34) and for automatically initiating said second communication (provide analog clear voice over PSTN 118 id 2:26-54) with said second communication device using said identification code, said second communication using a second service option (end-to-end unencrypted channel).

Regarding claim 4, Hardy teaches a receiver (keypad inherently part of a cellular phone) for receiving said identification code (second communication device phone number) during said first communication;

Said processor further for storing said identification code in said storage device (inherently part of a cellular phone as all dialed numbers are stored before dialing).

Regarding claim 5, Hardy teaches a DTMF demodulator (inherently part of a cellular phone as all cellular phones use DTMF and id 6:60-65).

Regarding claim 7, Hardy teaches a method of transparent service option transition between a first communication device (digital subscriber unit 220 on Fig. 1 and id 2:37-39, 53-60) and a second communication device (analog terminal 232 on Fig. 1 and id 2:37-41, 50-52), comprising the steps of:

Establishing a first communication (establish unencrypted digital link 104-108 on Fig. 3 and id 2:64-67, 3:1-18, 29-34) with said second device using a first service option (end-to-end unencrypted channel);

Transmitting request (secure voice over the air only 110 on Fig. 3 and id 5:19-25) to transition said first communication to a second communication (provide analog clear voice over PSTN 118 id 2:26-54) using a second service option (encrypted digital link and unencrypted analog link); and

Transitioning said first communication to said second communication (tasks 114-118 on Fig. 3 and id 2:19-24).

Regarding claim 12, Hardy teaches transitioning said first communication to a second communication, comprising the step of modulating said request using DTMF modulation (predetermined dialed code from a standard telephone, inherently DTMF code, because DTMF is a preferable method for dialing a code from an analog telephone id 6:46-65).

#### ***Allowable Subject Matter***

3. Claims 3, 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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4. Claims 10 and 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carter            US006266418B1      Encryption and authentication methods and apparatus for securing telephone communications.

Cox             US005594798A      Secure telecommunications.

Stewart        US005592555A      Wireless communications privacy method and system.

Watson         US005818937A      Telephone tone security device.

Thompson      US005335276A      Communication system and methods for enhanced information transfer.

Coe             US004167700A      Digital voice protection system and method.

Alanaraet      US005594797A      Variable security level encryption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Levitan whose telephone number is 703-305-4384. The examiner can normally be reached on 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 703-305-4744. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Dmitry Levitan  
Patent Examiner.  
May 1, 2003



HASSAN KIZOU  
SUPERVISORY PATENT EXAMINER  
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